

Attorney Docket No. 4652-14US

**REMARKS**

Claims 1-31 are pending in this application. Claims 1, 4, 13, 16, 20, 22, 23, and 25 have been amended by this Amendment.

The Office Action dated December 29, 2004 objected to the claims. The Office Action also rejected all of the pending claims (claims 1-31) as being indefinite under 35 USC 112, second paragraph; as being directed to non-statutory subject matter; and as being anticipated by prior art.

**Drawings**

The Office Action Summary contains a check box indicating that the drawings are objected to by the Examiner. However, the Office Action itself does not indicate that there is any objection to the drawings and does not indicate any reason for an objection. Applicants request that the next Office Communication contain a clarification of any reason for an objection to the drawings. In the absence of a clarification, applicants will assume that there is no objection to the drawings.

**Claim Objections**

On page 2, the Office Action objected to the claims because the term "respondant" used in the claims is believed to be a misspelling. As requested, applicants have changed the term "respondant" to "respondent" throughout the claims in this Amendment. It is respectfully submitted that the objection has been satisfied by these changes to the claims. The scope of the claims has not been changed by these amendments.

**Indefiniteness Rejection**

The grounds for the rejection of the claims as being indefinite under 35 USC 112, second paragraph, is set forth on pages 2-3 of the Office Action. The rejection objects to the lack of proper antecedent basis or to confusing antecedent basis in several of the claims. Applicants have changed the claims as suggested in the rejection to overcome the rejection by clarifying the antecedent basis in the claims without changing the scope of the claims.

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**Non-Statutory Subject Matter**

The grounds for the rejection of the claims under 35 USC 101 as being directed to non-statutory subject matter is set forth on pages 3-4 of the Office Action. Applicants respectfully traverse the rejection. The claims explicitly recite that they are directed to a method implemented by a computer system. Applicants respectfully submit that such a method is statutory subject matter under 35 USC 101.

**Anticipation Rejection**

The grounds for the rejection of the claims as being anticipated by prior art under 35 USC 102(b) is set forth on pages 4-10 of the Office Action. The rejection asserts that the claims are anticipated by the method disclosed in U.S. Patent Application Publication No. 2002/0099645 by Agarwal et al (this prior art method is hereinafter referred to simply as "Agarwal"). Applicants respectfully traverse the rejection because it fails to establish a prima facie case that Agarwal includes each and every one of the combination of features recited in the rejected claims.

For example, independent claims 1 and 20 (each one of claims 2-19 and 21-31 are dependent on one of claims 1 and 20) recite providing a list creation state to enable the initiator "to enter, through a user interface, a list of items of buying or selling interest..." The rejection relies upon paragraph 103 of the publication, which describes the interface shown in Fig. 3. However, this interface is for showing a calendar/inventory of new issues of debt securities and is not a list of debt securities in which the user has a buying or selling interest (see also paragraphs 104-109).

It is the interface shown in Fig. 5 that allows the user to create an indication of a buying or selling interest (see paragraphs 112 and 113). It can be seen from Fig. 5 that only a single debt security (issued by Acme Widgets Corp.) can be entered into the interface for buying or selling. Thus, Agarwal clearly does not provide a list creation state permitting the user to "to enter, through a user interface, a list of items of buying or selling interest..." as recited in the claims.

The rejection also relies upon paragraphs 131, 126, 142 and 144 as showing the other respective steps recited in the independent claims of: providing a list response state...; providing a list trade state...; providing a list pricing state or spotting state...; and providing a

list complete state.... Paragraphs 131, 126, 142 and 144 correspond to Figs. 12, 10, 15 and 16 in the publication, respectively.

The rejection does not appear to realize that Figs. 10-18 relate to an embodiment for secondary market trading of debt securities, whereas Figs. 4-9 relate to a different embodiment for primary market (new issue) trading of debt securities. Because the rejection relies (perhaps even unknowingly) on the combination of parts of one embodiment with the parts of another embodiment, the anticipation rejection is not proper. To anticipate the rejected claims, a single prior art method must itself include each and every one of the combination of features recited in the claims.

Even if one looks only at the embodiment shown in Figs. 10, 12, 15 and 16, it can be seen that it does not anticipate the claims. Fig. 10 shows a list of calendar/inventory debt securities rather than a list of entered items of buying or selling interest and thus fails to anticipate the recited list creation state for at least the same reasons discussed above with respect to Figs. 4 and 5.

It is also apparent that each one of Figs. 12, 15 and 16 show a single debt security rather than a list of debt securities as recited in the claims. The other recited steps in the independent claims relate to the same list and there is no anticipation because of this significant difference. It is also noted that the claims recite that the items on the list can be processed independently in the list response state and list trade state for "a single item, multiple items, or all items on the list." This obviously does not occur in Figs. 12 and 15.

The rejection relies upon the same paragraph 142 for the list pricing state recited in independent claim 1 and the list spotting state recited in independent claim 20. These two states in the different claims are different from each other notwithstanding that the rejection fails to distinguish them. The cited paragraph clearly does not suggest the spotting state recited in claim 20, and the rejection of claim 20 is improper for this additional reason.

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**Conclusion**

For at least the above reasons, applicants submit that the claims are allowable over the cited prior art and that all of the raised objections and rejection have been overcome or otherwise addressed. A prompt Notice of Allowance is respectfully requested.

Please charge any fees due in connection with the filing of this Amendment, to Deposit Account No. 02-4270 (Dkt. No. 4652-14US) and please credit any overpayment or excess fees to such deposit account.

Respectfully submitted,



Robert M. Bauer, Registration No. 34,487  
Brown Raysman Millstein Felder & Steiner, LLP  
900 Third Avenue  
New York, NY 10022  
Tel.: (212) 895-2000  
Fax: (212) 895-2900